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In re Application of GOTO et al :  
U.S. Application No.: 10/541,518 :  
PCT Application No.: PCT/JP2003/015731 :  
Int. Filing Date: 09 December 2003 : DECISION  
Priority Date Claimed: 15 January 2003 :  
Attorney Docket No.: 81864.0064 :  
For: PATTERN FORMATION DEVICE, :  
PATTERN FORMATION METHOD AND :  
PATTERN FORMATION SYSTEM :

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a) for Filing on Behalf of a Joint Inventor Who Refuses to Sign" filed 13 July 2006.

**BACKGROUND**

On 09 December 2003, applicant filed international application PCT/JP2003/015731, which claimed priority of an earlier Japan application filed 15 January 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 29 July 2004. The thirty-month period for paying the basic national fee in the United States expired on 15 July 2005.

On 07 July 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 09 February 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 13 July 2006, applicant filed the present petition under 37 CFR 1.47(a).

On 24 August 2006, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

### DISCUSSION

The Notice of Acceptance of Application Under 35 U.S.C. 371 was sent in error.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declaration submitted with the petition does not satisfy 37 CFR 1.69(b).

37 CFR 1.69(b) states,

Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

The declaration does not use an official form provided by the USPTO, i.e. USPTO Form PTO/SB/106. Applicant must submit either: (1) a declaration using USPTO Form PTO/SB/106 or (2) a statement that the translation contained in the submitted declaration is accurate.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Hideki Kishi refuses to sign the application papers. Although the petition sufficiently establishes that a bona fide attempt was made to present a copy of the application papers to Kishi for signature (see affidavit of Miyuki Horikawa, ¶2), it cannot be determined whether Kishi actually received the correspondence that was sent to him. Petitioner is advised that Exhibits B, C, and D will not be considered until an English language translation is provided. Until it can be shown that Kishi in fact received the mailings, it would not be reasonable to conclude that his purported failure to reply constitutes a refusal to cooperate. In the event that it is determined that the letters sent to Kishi were not received, petitioner may consider a claim that Kishi cannot be reached after diligent effort.

With regard to item (3) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to \$200.00. Any deficiency in the petition fee will be charged to Deposit Account No. 50-1314 as authorized by applicant.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

The Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 24 August 2006 is hereby VACATED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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